



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Confirmation No.: 4429

BARNETT et al.

Group Art Unit: 3622

Serial No.: 09/754,378

Examiner: DURAN, ARTHUR D.

Filed: January 5, 2001

Title: METHOD AND SYSTEM FOR ELECTRONIC DISTRIBUTION OF PRODUCT REDEMPTION
COUPONS

Date:

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I. INTRODUCTION

This Reply Brief is being filed within two months of the Examiner's Answer mailed April 27, 2005. This Brief responds to the points raised by the Examiner's Answer.

A. The Status of the Claims

Claims 76-112 are pending in the application. Claims 82 and 91 stand rejected under 35 U.S.C. §112, first paragraph. Claims 76-112 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh.

Appellants note the rejection of claims 76-112 under the judicially created doctrine of obviousness-type double patenting over claims 63-74 of co-pending Application Serial No. 09/321,597, as well as the rejection of claims 76-81 and 83-89 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,321,208. See Final Action, at pgs. 2-3.

As previously stated in Appellants' Appeal Brief, Appellants disagree with the double-patenting rejections set forth by the Examiner, however Appellants will not address these rejections in the Reply Brief. Rather, Appellants will file a terminal disclaimer upon the indication of allowable subject matter. Appellants further note that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d (BNA) 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

II. RESPONSE TO EXAMINER'S ARGUMENTS

A. The Examiner erroneously alleges that the specification fails to provide support for claimed limitations under 35 U.S.C. §112, First Paragraph.

1. The Examiner's Response to Arguments Regarding No Support in the Specification For Claims 82 and 91 are incorrect.

- a. "coupon is provided to the user via an electronic mail message" (claim 82)

With regard to claim 82, the Examiner erroneously alleges that Appellants' Specification does not disclose electronic email messaging for providing coupons to a user. On page 16, line 5 of the Examiner's Answer, the Examiner alleges that Appellants'

Specification only provides support for electronic transmittals such as downloading, in providing coupons to a user. Clearly, an email is in fact an electronic transmittal. Moreover, Appellants' Specification, is not limited to electronic transmittals, in the terms of downloads. For example, as previously referred to in the Appellants' Appeal Brief, page 14 line 29-30 of Applicants' Specification states:

In addition, it is contemplated that the electronic coupon data distribution may be carried out by connection to any readily accessible Internet site. **page 14 line 29-30**

For at least these reasons, the specification supports electronic transmission including emails.

- b. "wherein downloading the incentive data management software module comprises downloading the unique identifier" (claim 91)

With regard to claim 91, the Examiner's Answer erroneously alleges that Appellants' Specification does not provide support for the above combination of features. *See* page 16 lines 9-14. Appellants' Specification, however, discloses that coupon management routines are downloaded to the user's computer with an encoded unique identifier. For example, Appellants' Specification discloses:

In this embodiment, the downloaded coupon management routines are encoded with a unique user identification number, which may be for example the user's email Internet address. **page 32 lines 20-23.**

In another embodiment, Appellants' specification discloses fixed coupon parameters, including a unique identifier, being transmitted to a user during initialization (or sign-up) for the coupon management program. *See, e.g.,* page 11 lines 4-7 and page 25 line 7-21.

Therefore the Appellants' Specification clearly supports downloading an incentive data management software module comprising and unique identifier.

B. The Examiner has Incorrectly Applied the Alleged Teachings of Von Kohorn in view of Saigh under 35 U.S.C. §103.

With regard to claims 76-112, the Examiner legally erred in rejecting the claims under 35 U.S.C §103(a) over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh et al (hereinafter referred to as "Saigh"). As recited in the

Appellants' Appeal Brief, claims 76-112 are patentable for *at least* the reasons that: (1) the Examiner relies on non-analogous art for the rejection of claims 76-112; and (2) assuming *arguendo* that the art is deemed analogous, there is no legally proper teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh; and finally (3) assuming *arguendo* that there is legally proper teaching, suggestion or motivation to combine the references, Von Kohorn and Saigh fail to disclose, teach, or suggest all of the elements of claims 76-112. Therefore, the Examiner's Answer has failed to establish a prima facie case of obviousness under 35 U.S.C. §103(a).

1. *The Von Kohorn Patent and Saigh Patent are Non-Analogous Art.*

The Examiner's Answer fails to overcome the deficiencies in the rejection, which fail to establish Von Kohorn and Saigh as analogous references. (See Examiner's Answer at page 17 line 4- page 18 line 20). The Examiner's Answer fails to even address the points raised in the Appellants' Appeal Brief of March 10, 2005, regarding non-analogous art, specifically that, (1) the references are outside the Appellants' field of endeavor and (2) that the references are not reasonably pertinent to the particular problem with which Appellants were involved. The Examiner's Answer only cites selected passages within Von Kohorn and Saigh in an attempt to demonstrate the relevance of both Von Kohorn and Saigh to the Appellants' claims. This is not the correct legal test. For example, the Examiner's Answer states on page 18 lines 18-20 that, "both Von Kohorn and Saigh provide information and content to the user that can include promotions, advertising, and coupons. Therefore, Von Kohorn and Saigh are analogous art relevant to the Appellant's claims".

Just because a potential prior art reference may have something in common with the claimed invention does not necessarily mean that the reference qualifies as prior art that can be considered in an obviousness analysis. To the contrary, only "analogous art" may be considered. The examiner has not shown that any of the references upon which it relies qualify as analogous art. Absent such a showing, these references cannot be used in a Section 103 defense. *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1992).

The identification of analogous art is a factual inquiry that requires determining (1) "whether the art is from the same field of endeavor" as the invention, and if not, (2) "whether it is still reasonably pertinent to the particular problem to be solved." *Wang Labs.*, 993 F.2d at 864 (citation omitted). This two-step analysis frequently demonstrates that references that

might appear relevant to a claimed invention are not analogous and therefore may not properly be considered.

Many examples demonstrate this. The Federal Circuit confirmed that the art of petroleum extraction is not analogous to the art of petroleum storage despite both being in the petroleum industry. *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992). Fasteners for garments are not analogous to fasteners for a hose clamp. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Paper stapling is not analogous to surgical stapling. *U.S. Surgical Corp. v. Hospital Prods. Int'l Pty., Ltd.*, 701 F. Supp. 314, 334 (D. Conn. 1988). Single in-line memory modules (SIMMs) for an industrial controller is not analogous to SIMMs for personal computers. *Wang Labs.*, 993 F.2d at 864. Railway car brakes are not analogous to automotive vehicle brakes. *SAB Industri AB v. The Bendix Corp.*, 199 USPQ 95, (E.D. Va. 1978). These cases are important here because Von Kohorn and Saigh are not analogous to the claimed invention.

a. *The references are outside Appellants' field of endeavor.*

For example, Von Kohorn and Saigh do not even relate to Appellants' field of endeavor for claims 76-112, which relates to electronic distribution of secure, trackable, money saving or discount coupons and/or other marketing incentives, and in particular to the use of a centrally located online computer system for interactively distributing such coupons to remotely connected consumer computers and for collecting user-specific data regarding coupon usage and user demographic information from the remote computer to eliminate fraud. See Specification, e.g. page 1 lines 3-10; page 8 lines 17-25 and page 9 lines 11-15.

The Examiner's Answer cites passages which appear to address distribution of broadcast signals related to television game or quiz shows, wherein prizes relating to various products may be won. Thus, by the Examiner's own admission, Von Kohorn is primarily concerned with a television broadcast system, not an interactive coupon distribution system. Additionally, prizes are an auxiliary component to the main purpose of Von Kohorn, which is to quantify and measure impact of advertisements. For example, the Examiner's Answer cites col. 2 lines 45-57, col. 5 lines 56-61; col. 22 lines 1-11, which disclose game or quiz shows wherein incentives may be won. Von Kohorn discloses the following:

Persons exposed to the stimulus of a television, radio or printed advertisement or other promotion are given an opportunity to respond to a task, such as the selection of an advertised product or to provide an answer to a question. Following a response, such persons receive a token having value, such as a coupon carrying a discount on the product featured in the advertisement. In the case of a correct answer to a question, a shopper's response is entered in a programmed response unit, which evaluates and scores the response and which prints a discount coupon specifying the advertised product. **col. 2 lines 45-57**

FIG. 29 is a block diagram of a further embodiment of the invention wherein a central station and a set of remote playing stations are employed to conduct a wagering game including the issuance of coupons, or other form of wagering record, in a forgery proof system; **col. 5 lines 56-61;**

The degree of difficulty will normally determine the value of the prize, etc. The device evaluating the responses may dispense records, e.g. coupons, certificates and the like of different value or in different denominations. For instance, it may issue a 10 cent coupon at level 1, and 25 cent coupon at level 2, and a 50 cent coupon at level 3. The coupons may be redeemed in retail establishments, the coupons being similar to those contained in newspapers. **col. 22 lines 1-11,**

These and the other passages cited in the Examiners Answer including (1) col. 74 lines 33-55; (2) col. 47 line 40- col. 48 line 2; and (3) col. 2 lines 45-52 are directed to measuring the impact of stimuli on individuals and quantifying effects of advertising using televised game shows. Von Kohorn is not primarily directed to a coupon distribution system. Just because Von Kohorn may mention coupons, does not necessarily mean that it is within the Appellants' field of endeavor. For example, the prizes in Von Kohorn are not seen to be secure or trackable nor is there an interactive couponing system. See citation below directly from Von Kohorn, col. 1 lines 20-24:

This invention relates to the measuring of the impact of stimuli on individuals and, more particularly to evaluating the short term and long term effectiveness of broadcast and print stimuli under varying circumstances. **col. 1 lines 20-24**

The Examiner has failed to meet the burden of establishing this prong of the test.

Saigh also is outside the inventors' field of endeavor. The Examiner's Answer alleges that the following passages of Saigh show relevance to the present invention, (1) col. 1 lines 38-41; (2) col. 5 lines 20-30; (3) col. 14 lines 60-65; (4) col. 8 lines 3-6; and (5) col. 8 lines 59-61. Again, this is not the proper legal test. None of the cited passages, however, show a system for interactive distribution of secure, trackable coupons and/or the collection of user-

specific data regarding coupon usage from the remote computers. Rather, they are more concerned, generally, with the distribution and publication of information from a central database system to multiple receiving remote users. See col. 1 lines 13-16 (“The present invention relates to a system for distributing information in electronic form and more particularly, relates to a communication network for transmitting information between a central information bank and a user interface.”) The Examiner has not even alleged that Saigh relates to security of the transmitted information or tracking of user activity. Rather, the Examiner has merely cited passages within Saigh that have the keyword “coupon” or “promotions”. Citing these passages alone, do not show how Saigh, as a whole, is directed to the same field of endeavor.

- b. *The references are not reasonably pertinent to the particular problem(s) with which Appellants were involved.*

Since Von Kohorn and Saigh are outside the inventors’ field of endeavor, the test becomes whether the references are reasonably pertinent to the particular problems with which the inventor is concerned. Neither Von Kohorn nor Saigh are reasonably pertinent to the problems addressed by the inventors’. The problems with which the Appellants are involved include, for example, deterring fraud in connection with an interactive coupon distribution system and tracking user activity. See Appellants’ Appeal Brief at page 16-17 for a more complete list.

As previously pointed out in the Appellants’ Appeal Brief of March 10, 2005, the Examiner cites no evidence that a person of ordinary skill in the art would reasonably have expected to solve the problems addressed in the present invention (see complete list on page 16-17 of Appeal Brief) by considering the problems addressed in either Von Kohorn or Saigh. The Examiner’s Answer also fails to produce such evidence. Rather, the Examiner attempts to cite selected passages in both Von-Kohorn and Saigh having the keyword “coupon” included within them. However, neither references is concerned with determining coupon fraud. This makes sense in part, because neither is primarily a coupon distribution system.

As detailed above, Von Kohorn is directed to the problem of quantifying the effects of advertising. See Von Kohorn, col. 1, lines 43-49 and lines 55-58 cited below:

It therefore is an object of the present invention to quantify the initial impact and the continuing effectiveness of advertising on shoppers with respect to an identified advertisement in terms of the purchase of the advertised product. It is another object to measure the magnitude of sales which are lost and are excluded from a shopper's intended purchases. **col. 1 lines 43-49**

It is another object of the invention to quantify the impact on shoppers of a number of controlled variables of an advertising or promotional campaign, individually or in combination. **col. 1 lines 55-58**

Von Kohorn is not concerned with deterring fraud in print-at-home coupons. Nor does Von Kohorn address the problem of tracking user activity. Nor is it even a couponing system. Coupons are ancillary to the main issue related to measuring the effects of stimuli.

Saigh is concerned with providing improved dissemination of proprietary information. See Saigh, col. 2 lines 56-60 cited below:

Widespread use of the present invention should greatly simplify, and reduce the costs associated with, the publication and distribution of information. Particularly, the present architecture reduces the amount of time and resources required for the distribution of information. **col. 2 lines 56-60**

The Examiner does not even address that Saigh is concerned with security of the transmitted information, much less deterring fraud in print-at-home coupons. Nor does the Examiner even allege that Saigh relates to tracking user activity.

A person having ordinary skill in the art would not reasonably have expected to consider the references because the subject matter with which Von Kohorn and Saigh deal, logically would not commend themselves to an inventor's attention in considering the present problem solved. For example, to solve the problem of generating unique, secure, trackable coupons to deter the possibility of fraud, one of ordinary skill in the art would not logically have considered the problem of quantifying the effects of advertising or the problem of providing networks with more efficient dissemination of information.

The Examiner's rejection has failed to provide evidence that shows the two reference are analogous. For at least the foregoing reasons, Von Kohorn and Saigh are non-analogous to the invention to claims 76-112. The rejection based thereon should be therefore reversed.

2. *No Proper Suggestion or Motivation to Modify Von Kohorn to Include the Teachings of Saigh.*

Assuming *arguendo* that the art is found to be analogous, there is no legally proper teaching, suggestion or motivation to modify Von Kohorn to include the teachings of Saigh. Claims 76-112 are directed toward distribution of coupons over the Internet. Examiner's Answer at page 19, lines 12-14 at best alleges, "that Von Kohorn discloses utilizing a home computer in communication with other computers by way of network utilizing cable connection or telephone connection". The Examiner has mischaracterized Von Kohorn. For example, the reference does not disclose a network of computers, much less a home computer in communications with other computers. Von Kohorn, col. 47, lines 40-47, recites:

Frequently, in television programs listing items of merchandise and services available to viewers, sometimes referred to as Videotext, interested viewers who are potential buyers have the opportunity to request additional or supplemental information over cable connections such as cable or telephone connections used for home computers. **col. 47 lines 40-47**

As such, the cable and telephone connection are used for transmission of television signals. A network of computers is not disclosed. The Examiner attempted to add Saigh to Von Kohorn in order to provide Von Kohorn with further communications capabilities via the Internet. However, the Examiner fails to present a legally proper foundation for such a combination. The general allegation that the Internet is a far reaching network and readily available (see Examiner's Answer at page 19, lines 21-22), does not adequately reflect why it would have been obvious to modify the particular system and method of Von Kohorn, which discloses measuring the effects of televised advertisements. In fact, since Von Kohorn is based on a television broadcast system, this would teach away from that. This is a classic case of hindsight with no evidentiary support for a suggestion to combine.

3. *Von Kohorn and Saigh, even when combined, fail to disclose, teach, or suggest all of the elements of claims 76-112.*

Assuming *arguendo* that Von Kohorn and Saigh could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claims 76-112. The Examiner's Answer cites numerous passages from Von Kohorn and Saigh, all of which fail to address each and every claim limitation. The Examiner attempts to cite passages from

various sections of the Von Kohorn reference with out regarding the teachings of Von Kohorn as a whole. The cited passages, which the Examiner has taken out of context, when viewed with respect to the entire reference, makes clear that Von Kohorn fails to disclose, teach, or suggest all of the elements of claims 76-112. It is legally improper for an Examiner to hunt and peck through a reference in this way in an attempt to prevent an applicant from obtaining a patent.

a. Independent claims 76 and 112

Independent claims 76 and 112 recite, among other things, the claim feature of, **“storing at an Internet-accessible location incentive information pertaining to a group of available incentives”**.

In the Final Action the Examiner alleged that the following passages of Von Kohorn disclose this claim element: (1) col. 74 lines 33-40; (2) col. 16 lines 30-40; (3) col. 19 lines 20-39; (4) Fig. 29, item 904; (5) col. 94 lines 35-41; (6) col. 95 lines 5-10; (7) col. 45 lines 41-44. None of these passages teach storing electronic coupon data at an Internet accessible location. The Examiner’s Answer cites col. 76 lines 56-59 of Von Kohorn, which shows that the coupons are imprinted with material based on instructions and data stored in the program memory 330. *See* Examiner’s Answer at page 23 lines 13-18. Program memory 330 is part of a customers response unit, not an Internet accessible location. Thus, the rejection fails to show storing the electronic coupon data at an Internet accessible location.¹

The Examiner does not even allege that Saigh cures this deficiency.

Independent claims 76 and 112 recite, among other things, the claim feature of, **“receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information”**.

Since it has been established, according to the arguments above, that the Examiner has not shown a central broadcast station actually storing coupon data, it correctly follows that the remote user would not request access to coupon data stored at the central station.

The Examiner’s Answer alleges that col. 47 line 40- col. 48 line 2 show that the consumer can indicate an interest in a product and the incentives can be sent to the consumers

in response to the consumers interest. *See* page 21 lines 17-19 of Examiner's Answer. Von Kohorn discloses:

Frequently, in television programs listing items of merchandise and services available to viewers, sometimes referred to as Videotext, interested viewers who are potential buyers have the opportunity to request additional or supplemental information over cable connections such as cable or telephone connections used for home computers. The purpose of such additional information is to help potential buyers to make up their minds whether the item is of interest. **col. 47 line 40-49.**

Even if, Von Kohorn discloses a consumer requesting additional information this does not indicate that a coupon is actually available for the product.

In a second embodiment, a user may request to be alerted when an incentive for a selected product becomes available. *See* Von Kohorn col. 99 lines 49-64. This is not a request for access to incentive information stored at an internet accessible location. Among other things, the alert processing occurs at the remote terminal after broadcast transmissions are received. This stands in stark contrast to the invention which enables a user to access coupons via an internet accessible location (e.g., a coupon website).

In fact, the Examiner does not even allege that Von Kohorn enables a remote user to *request* access to view incentive information stored at the central broadcast station (emphasis added). It is important to note the distinction between Von Kohorn and present invention because Von Kohorn is a television broadcast system, and there is no ability for the viewer to request stored information. Rather, the user may select from information already broadcast from a central broadcast station and that is received by the response unit.

Therefore, the Examiner has failed to provide evidence that Von Kohorn teaches this claim feature. The Examiner does not even allege that Saigh cures this deficiency.

Independent claims 76 and 112 recite, among other things, the claim feature of, **“determining at the Internet-accessible location if the user is a registered user, and if the user is not registered: transmitting a prompt to the user's remote terminal to electronically complete a users profile”.**

The Examiner's Answer alleges that the following passages disclose the claim feature: (1) col. 3 lines 56-66; (2) col. 94 line 56-70; (3) col. 97, line 64- col. 98 line 5; (4)

¹ To the extent that Von Kohorn shows a central station that broadcasts instructional signals, the Examiner does not show that the central station actually stores coupon data.

col. 100, lines 42-50; (5) col. 103 line 65- col. 104 line 3. None of these passages, however, show the claim feature of determining whether a user is registered or not. In fact, in one embodiment, Von Kohorn appears to disclose that each response unit is registered in the name of an identified individual. *See* col. 97 line 64- col. 95 line 5. This, however, does not teach an Internet accessible location *determining if* the user is registered (emphasis added). In another embodiment, Von Kohorn appears to disclose soliciting a user to register an interest in a product. Von Kohorn states the following:

Advertisement 1001 also may promote a service, an organization, a resort, or any offering to the public herein collectively referred to as product. The individual 1003 who is persuaded by the said stimulus to become a buyer, lessee, etc. of the promoted product, registers his or her intent to acquire the product identified in the advertisement 1001 in step 1004, which is an entering in the coupon dispenser or response unit 1005 of a request for a record 1008 described in FIG. 33. **col. 100 lines 40-48**

Registering an intent to acquire a product identified in an advertisement does not disclose registering a user, much less determining whether a user is registered or not.

In neither case does the Examiner show the user receiving a prompt in order to complete a user profile. Saigh also fails to cure the deficiencies of Von Kohorn. The Examiner's Answer fails to present a proper rejection for the claim feature.

Independent claim 76 recites, among other things, the claim feature of, **"if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information"**.

The Examiner's Answer alleges (page 26, lines 5-8) that any selection of coupons from available coupons is a selection of a subset of coupons. This, however, fails to address the complete claim limitation, which recites, "viewing a subset of incentives from a group of available incentives, the subset of incentives being based on user specific information, which comprises at least one of user profile information and user usage history information." Rather, as stated by the Examiner, the rejection shows the subset of coupons being based on user selection. User selection is not the same as user profile information and the user usage information.

Furthermore, the Examiner's Answer alleges that the following passages disclose the claimed features: (1) col. 1, lines 25-43; (2) col. 1 line 59- col. 21 line 11; (3) col. 3, line 55- col. 4 line 2; and (4) col. 106, lines 1-10. None of these passages address the user viewing a subset of incentives based on at least user profile information and usage history information. The Examiner does not even allege that Saigh cures this deficiency.

Independent claims 76 and 112 recite, among other things, the claim feature of, **"downloading to the user's remote terminal an incentive data management software ...the user selecting one or more incentives from the subset of incentives for printing...printing at the remote terminal, under control of the incentive data management software, one or more of the user-selected incentives"**.

The Examiner fails to show within the references, the features of downloading, to the user's remote terminal, an incentive data management software; selecting an incentive from a group of available incentives; or enabling the user to print incentives using the incentive data management software. The Examiner points to no evidence of a software downloaded in Von Kohorn. Rather, the Examiner relies upon "instructional signals" which are more akin to data than software. The Examiner's Answer states, "that when the user selects one coupon or more than one coupon that the user is selecting a subset of coupons. Any selection of coupon or coupons from available coupons is a selection of a subset of coupons." See page 26 lines 5-7 of Examiner's Answer. But this ignores certain claim language. As demonstrated above, there is no "subset of incentives" from which the user selects. Rather, of everything transmitted to the user, the Examiner alleges that what is selected becomes a subset.

The Examiner's Answer goes on to allege that Von Kohorn "discloses that the user can select a subset of promotions or coupons." See page 26 line 8 of the Examiner's Answer. The Examiner makes citation to col. 81 lines 6-24 to show this, but it is clear from reading the passage that a product listing is not a subset of incentives. The passage states:

The product signals may be modified at any time as directed by a sponsor. In the operation of the system described, a retailer prepares a listing of products selected for sales promotion in the target market. The products selected may be designated by name, but often are numbered and may be divided into categories. The products listings displayed at members, locations are grouped accordingly. If the product listing of a sponsor is lengthy, it can be displayed to members in successive segments or groupings. This is achieved by the use of known display and scrolling devices. Members' display devices may also be adapted to display and re-display successive listings of products or lists of numbered products in different categories as and when desired and such additional lists may be called up in sequence by a member of the

broadcast audience until a desired product category and/or a specific product is displayed which a member intends to buy. **col. 81 lines 6-24**

Thus, according to Von Kohorn, the user is not selecting and printing from a subset of incentives. The Examiner has failed to provide evidence to teach the claim feature.

Additionally, the Examiner fails to consider that the product list is presented in combination with a question that must be answered correctly in order to earn a coupon for the selected product. Von Kohorn discloses the following:

Using the split-screen television technique, the product information can conveniently be displayed along with other portions of the TV-program. This method is particularly easy and economical to implement on an automated cable channel, which for example can display concurrently a question and a product list. **col. 81 lines 35-40.**

In an alternative embodiment, a user may be alerted when a selected item goes on sale.

The selection of said item is stored in a memory coupled to the means informing shoppers of items chosen by the sponsor for promotion. The display and selection means are further provided with comparing means and alarm means, visual or audible, to inform or alert a shopper when the item of interest to the shopper is one chosen by the sponsor to which a prize is applicable. This method enables shoppers to wait until an item on a shopper's marketing list is announced as one eligible for a special prize and then attempt to qualify for such a prize by responding to a question. In such an event a shopper's product selection is entered prior to the entering of an answer or prediction. **col. 82 lines 21-23**

In neither case is the user selecting and printing from a subset of incentives stored at the central broadcast station. As such, in Von Kohorn, the user is not able to select and print from a subset of incentives. The Examiner does not even allege that Saigh cures this deficiency.

Independent claim 76 recites, among other things, the claim feature of, **"storing at the Internet-accessible location information regarding printed incentives"**.

The Examiner's Answer (see page 8 lines 20-22) alleges that the following passages disclose the claim feature: (1) col. 30 lines 41-46; (2) col. 3 lines 2-14; and (3) col. 39 lines 25-32. These passages do not disclose storing information regarding printed incentives at an

Internet-accessible location. The passages as cited below, show a cumulative record printed on a bulk mail postcard and sent to a retailer outlet or other research facility. Von Kohorn discloses the following:

Additional examples of response criteria and scoring mode are discussed herein. As example of a further signal, a fifth signal providing a verification code for use in verifying a printout of awards at a remote station may be sent subsequently along the same channel employed for transmission of the scoring criteria. **col. 30 lines 41-46.**

The response units at individual shoppers' locations have means for dispensing individual coupons following a response and for compiling a cumulative record of products for which the shopper has requested or selected discount coupons. Such a cumulative record can take the form of a tape intermittently printed as coupons are requested. Whereas the coupons are dispensed individually when printed as described in connection with the drawings, the tape matrix having the cumulative coupon data printed thereon is temporarily retained in the response unit in the form of a tape. **col. 3 lines 2-14.**

The symbols on the coupon may be in the form of preprinted sequential numbers, and the sweepstakes symbols may be transmitted from a central location as part of the instructional signals directing the printer to print the sweepstake symbols. In that event, a successful contestant discerns immediately whether he or she has qualified for a sweepstakes prize. **col. 39 lines 25-32.**

Von Kohorn, in no way, discloses storing a cumulative record at an Internet accessible location. The Examiner fails to provide evidence that Von Kohorn discloses the claim features. Saigh fails to cure this deficiency.

b. Dependent claims 77-111

The arguments and the cited passages from the Examiner's Answer, pages 21-36, fail to disclose each and every feature of claim 76, as detailed above. As such, Appellants submit that dependent claims 77-111 are allowable because they depend from allowable independent claims 76, as well as for the further limitation they contain.

Furthermore, the Examiner's Answer fails to provide any substantial new arguments that were not already fully addressed in Appellants' Appeal Brief of March 10, 2005. The comments presented in the Appeal Brief are relied upon here for separate patentability of the

claims. Therefore, the rejection on all the claims, 76-111, is improper and should be reversed.

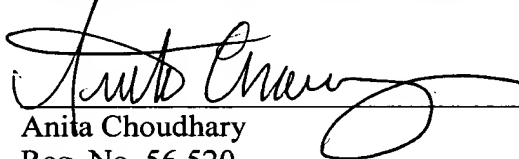
For at least these reasons set forth above, the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 76-112 are improper and should be reversed.

Appellants now appeal to this Honorable Board to promptly reverse these rejections and issue a decision in favor of Appellants. All of the claims are in condition for allowance.

DATE

Respectfully submitted,

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